

## REMARKS

Applicants have studied the Office Action mailed July 28, 2003 and have made amendments to the claims. It is respectfully submitted that the application, as amended, is in condition for allowance. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

### **Rejection of claims 18-19, 21, 37-38, and 40 under 35 USC §112, 1<sup>st</sup> paragraph:**

The Examiner rejected claims 18-19, 21, 37-38, and 40 under 35 USC §112, 1<sup>st</sup> paragraph, because the specification does not enable any person skilled in the art to make and use the invention commensurate in scope with these claims. The Examiner also rejected claims 18-19, 21, 37-38, and 40 under 35 USC §112, 1<sup>st</sup> paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Among the assertions made by the Examiner in making the rejection are the following. The Examiner states that the claims do not include a function limitation for the claimed nucleic acids. The Examiner states that there is not sufficient direction as to how to use the encompassed nucleic acids encoding polypeptides which do not function as an estrogen receptor. Since no functional language is associated with the claims one of ordinary skill in the art would not know how to use these defined sequences except in further characterization of the sequences themselves. The Examiner further states that, in the instant case, there are a large number of nucleic acid sequences which comprises at least 20 or 30 contiguous nucleotides of SEQ ID NO:1, with the T to C mutation, and a nucleic acid sequence which comprises nucleotides from 89803-89998 of SEQ ID NO:1, with the T to C mutation, however these sequences encode various unrelated proteins. Therefore, the Examiner states that, while the specification provides the necessary guidance to make the polynucleotides set forth in SEQ ID NO:1, it does not provide the necessary guidance for one of skill in the art to use the nucleic acid sequences which do not encode an estrogen receptor.

Applicants have hereby amended claims 18, 19, and 21, as indicated above, to include a functional limitation which clarifies that the claims are directed to nucleic acid molecules encoding an estrogen receptor  $\beta$  peptide.

### Conclusions

Claims 18, 19, and 21 have been amended by the present response, as indicated above. As such, claims 18-21, 26, 32, and 37-40 remain pending. The Examiner indicated in the July 28, 2003 Office Action that claims 20, 26, 32, and 39 are allowable.

The amendments to the claims and the newly added claims add no new subject matter and their entry is respectfully requested.

In view of the above remarks and amendments, Applicants respectfully submit that the application and claims are in condition for allowance, and request that the Examiner reconsider and withdraw the objections and rejections. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call the undersigned agent at (240) 453-3812 should the Examiner believe a telephone interview would advance prosecution of the application.

Respectfully submitted,

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